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Filing date: **03/30/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79147141
Applicant	KTM-Sportmotorcycle AG
Applied for Mark	E SPEED
Correspondence Address	DONALD L OTTO RENNER OTTO BOISSELLE & SKLAR LLP 1621 EUCLID AVENUE , NINETEENTH FLOOR CLEVELAND, OH 44115 UNITED STATES dotto@rennerotto.com
Submission	Applicants Request for Remand and Amendment
Attachments	20160330 Request to Remand and Amend.pdf(36303 bytes) Consent Agreement.pdf(115529 bytes)
Filer's Name	Don W. Bulson
Filer's e-mail	eorsine@rennerotto.com
Signature	/Don W. Bulson/
Date	03/30/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Trademark application of:

Applicant:	KTM-Sportmotorcycle AG
Serial No.:	79/147,141
Filing Date:	September 11, 2013
Mark:	E SPEED and design
Law Office:	101
Examining Attorney:	Saima Makhdoom
Attorney Docket No.:	SC&PT0125WOUS

**APPLICANT'S REQUEST TO SUSPEND THE APPEAL AND
REMAND FOR ADDITIONAL EVIDENCE**

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Applicant, pursuant to Trademark Rule 2.142(d), hereby requests that the instant appeal be suspended and that the application be remanded to the Examining Attorney for consideration of additional evidence that was not available until recently. The additional evidence is a Consent Agreement dated February 2, 2016, a copy of which is attached. The Consent Agreement is between the Applicant and Neumayer Tekfor Holding, GmbH (hereafter "Neumayer"). Neumayer is the owner of Trademark Registration No. 4,192,491 – ESPEED, upon which the Examining Attorney has refused registration of Applicant's applied-for mark on the basis of likelihood of confusion under Section 2(d) of the Trademark Act. Neumayer has consented to registration of the applied-for mark so long as Applicant amends and limits the applied-for mark to the following goods:

Class 006: License plate carriers of metal and competition number plates of metal, namely, metal competition plates for Motocross racing;

Class 007: Fans and cylinders for motors for two-wheeled vehicles; silencers for motors and engines for two-wheeled vehicles; exhausts, cylinder heads for engines for two-

wheeled vehicles; ignition devices for two-wheeled vehicles in the nature of ignition covers; and

Class 012: Electric motor powered two-wheeled vehicles and electrically powered two-wheeled vehicles and parts and accessories therefor, namely motors, tires, wheels, wheel rims, brake linings, brake discs, aero-dynamic fairings, luggage carriers for motorcycles; cases for luggage adapted for use with motorcycles, transport cases adapted for use with motorcycles, saddlebags adapted for use with bicycles and motorcycles, tank bags adapted for use with motorcycles, stands, mudguards, spoilers, after body, rearview mirrors, fuel tank caps, fuel tanks, bicycle chains, motorcycle seats.

In light of the probative nature of the Consent Agreement and amendments, Applicant requests that action on this appeal be suspended and that the application be remanded back to the Examining Attorney, and that the goods in the present application be amended as needed to correspond to the above goods.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

/Don W. Bulson/
By _____
Don W. Bulson
Registration No. 28,192
1621 Euclid Avenue, 19th Floor
Cleveland, Ohio 44115
Telephone: 216-621-1113
Facsimile: 216-621-6165
Email: dbulson@rennerotto.com

CONSENT AGREEMENT

THIS AGREEMENT effective as of the 2nd day of February, 2016, between NEUMAYER TEKFOR HOLDING GMBH, a Germany limited liability company having a place of business at Wilhelm-Zangen-Str. 9, 77756 Hausach, Federal Republic of Germany, (hereafter "NEUMAYER"), and

KTM AG (formally KTM-SPORTMOTORCYCLE AG), an Austria joint stock company having a place of business at Stallhofner Str. 3, A-5230 Mattighofen, Austria (hereafter "KTM").

WHEREAS, NEUMAYER is the owner of U.S. Trademark Registration No. 4,192,491 of the mark ESPEED (hereafter "NEUMAYER's ESPEED US registration") and International Registration No. 1090127 of the mark ESPEED, designating the US;

WHEREAS, KTM is the owner of International Registration Nos. 1203492, 1204325 and 1203491 of the marks E SPEED and device, each designating the US (US Application Nos. 79147141, 79147426, and 79147140) (hereafter "KTM's E SPEED and device US applications");

WHEREAS, the USPTO refused registration of KTM's E SPEED and device US applications as being confusingly similar to NEUMAYER's ESPEED US registration;

WHEREAS, the parties have mutually determined that if KTM limits the use of its E SPEED and device marks to the following goods/services, such use will not create a likelihood of confusion with NEUMAYER's ESPEED US registration:

Class 6: "License plate carriers of metal and competition number plates of metal, namely, metal competition plates for Motocross racing".

Class 7: "Fans and cylinders for motors for two-wheeled vehicles; silencers for motors and engines for two-wheeled vehicles; exhausts, cylinder heads for engines for two-wheeled vehicles; ignition devices for two-wheeled vehicles in the nature of ignition covers".

Class 12: "Electric motor powered two-wheeled vehicles and electrically powered two-wheeled vehicles and parts and accessories therefor, namely motors, tires, wheels, wheel rims, brake linings, brake discs, aero-dynamic fairings, luggage carriers for motorcycles; cases for luggage adapted for use with motorcycles, transport cases adapted for use with motorcycles, saddlebags adapted for use with bicycles and motorcycles, tank bags adapted for use with motorcycles, stands, mudguards, spoilers, after body, rearview mirrors, fuel tank caps, fuel tanks, bicycle chains, motorcycle seats".

NOW, THEREFORE, in consideration of the mutual covenants and undertakings expressed herein, the parties hereby agree as follows:

1. KTM agrees to limit its goods to the goods identified above.
2. NEUMAYER consents to KTM's use and registration of its E SPEED and device marks in KTM's E SPEED and device US applications for the goods identified above, and states that such use does not create a likelihood of confusion with NEUMAYER's ESPEED US registration.
3. If either party should become aware of any instances of actual confusion between the parties with respect to their respective uses of their respective marks for their respective goods, that party will promptly notify the other party of the circumstances of such confusion, and both parties shall cooperate in taking any reasonable action for avoiding any further confusion.

IN WITNESS WHEREOF, the parties have caused this Agreement to be executed by their duly authorized officers effective on the date and month first above written.


NEUMAYER TEKFOR HOLDING GMBH
KTM AG